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FAIRCHILD SEMICONDUCTOR CORPORATION

UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

ALPHA & OMEGA SEMICONDUCTOR, INC., a California corporation; and ALPHA & OMEGA SEMICONDUCTOR, LTD., a Bermuda corporation,

Plaintiffs and Counterdefendants,

v.

FAIRCHILD SEMICONDUCTOR CORP., a Delaware corporation,

Defendant and Counterclaimant.

AND RELATED COUNTERCLAIMS.

Case No. C 07-2638 JSW (EDL)
(Consolidated with Case No. C 07-2664 JSW)

FAIRCHILD SEMICONDUCTOR CORPORATION'S NOTICE OF MOTION AND MOTION TO COMPEL RESPONSES TO INTERROGATORIES AND PRODUCTION OF DOCUMENTS

Date: December 11, 2007
Time: 9:00 a.m.
Courtroom: Courtroom E, 15th Floor

Hon. Elizabeth D. Laporte

TO PLAINTIFFS AND COUNTERDEFENDANTS ALPHA & OMEGA SEMICONDUCTOR, INC., AND ALPHA & OMEGA SEMICONDUCTOR, LTD.:

PLEASE TAKE NOTICE THAT pursuant to Federal Rule of Civil Procedure 37(a)(2)(B) and Northern District of California Civil L.R. 7-1, 7-2, and 37-2, Defendant and Counterclaimant Fairchild Semiconductor Corporation ("Fairchild") hereby moves the Court for an Order To Compel Responses To Interrogatories And Production Of Documents. Specifically, Fairchild moves this Court to order Plaintiffs and Counterdefendants Alpha & Omega Semiconductor, Inc., and Alpha & Omega Semiconductor, Ltd. (collectively, "AOS") to provide full and complete discovery responses regarding all AOS trench power MOSFET products accused of infringement in this case.

This motion will be heard in Courtroom E, 15th Floor, of the Northern District of California, San Francisco Division, located at 450 Golden Gate Avenue, San Francisco, California, on December 11, 2007, at 9:00 AM, or as soon thereafter as counsel may be heard, or at such other date and time as the Court orders *sua sponte* or pursuant to the Motion to Change Time To Consolidate The Hearing Dates On Discovery Motions, filed concurrently herewith. This motion is based on this notice and memorandum, the attached declarations and exhibits, the oral argument to be heard at the hearing on this motion, and any and all papers on file in this proceeding.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Fairchild filed its complaint for patent infringement against AOS on May 18, 2007. In its Disclosure of Asserted Claims and Preliminary Infringement Contentions ("PICs"), Fairchild specifically identified 342 AOS power MOSFET[1] products as infringing Fairchild's asserted patents. AOS seeks to limit its discovery obligations in this case to eighteen AOS products, including fourteen

[1] A "MOSFET" is a Metal Oxide Semiconductor Field Effect Transistor. It is a semiconductor device that is used to switch current on and off. An "IGBT" is an Insulated Gate Bipolar Transistor. It is similar to a MOSFET in respects that are material to the Fairchild patents-in-suit. Based on information available to Fairchild from AOS's website at the time of service of Fairchild's PICs, it appears that AOS does not manufacture or sell trench IGBT products at this time. To the extent AOS does manufacture any trench IGBT products, Fairchild believes that such products also practice the asserted claims of Fairchild's patents and are included in Fairchild's discovery requests.

AOS products for which Fairchild provided claim charts and reverse-engineering analysis in its PICs, as well as four additional AOS products that are identified in a letter dated August 3, 2005, from Fairchild's Director of Patents to AOS's Chief Executive Officer. AOS's ostensible justification for unilaterally limiting its discovery obligations is its assertion that Fairchild's definition of "accused product(s)" in its discovery requests is so broad as to "encompass every electronic system device used by either AOS or its customers including, e.g., telephones and automobiles." AOS had previously taken the untenable position that its discovery obligations were limited to eight products listed in the August 3, 2005 letter, on the basis that Fairchild's PICs are "legally insufficient to identify more than the products identified by Fairchild in its August 3, 2005 letter." (Declaration of Igor Shoiket In Support Of Fairchild's Motion To Compel Responses To Interrogatories And Production Of Documents, ("Shoiket Decl."), Exh. 6). The day Fairchild filed the present motion, AOS abandoned this indefensible position in a letter from AOS's counsel to Fairchild's counsel. (Shoiket Decl., Exh. 7). Nonetheless, AOS still refuses to produce discovery on the other 324 products identified in Fairchild's PICs.

AOS's arguments are legally unsupported and factually incorrect. Fairchild has accused all of AOS's trench power MOSFET and IGBT products, whether sold by themselves or in modules with other electronic devices, and provided PICs explaining how the asserted claims of the Fairchild patents read on the accused products. AOS's attempts to limit its discovery obligations to a small subset of those products should be rejected, and AOS should be ordered to produce discovery on all of its accused trench power MOSFET and IGBT products.

Fairchild's counsel met-and-conferred in good faith with opposing counsel as required by Rule 37 of the Federal Rules of Civil Procedure, Civil Local Rule 37-1(a), and the Court's Order regarding Discovery Procedures in an effort to resolve this dispute without Court intervention. (Shoiket Decl., ¶¶ 7-9, and exhibits attached thereto).

II. BACKGROUND

Fairchild served its First Set Of Interrogatories To Alpha And Omega Semiconductor Limited and its First Set Of Requests For Production Of Documents To Alpha And Omega Semiconductor Incorporated and Alpha And Omega Semiconductor Limited on July 27, 2007. (Shoiket Decl., Exhs.

1 and 2). The first set of interrogatories and the first set of requests for production both include the following definition of "accused product(s)":

> 3. The term "accused product(s)" refers to any and all systems of products, including but not limited to modules, containing trench design power MOSFETs or IGBTs made, used, offered for sale, sold, or imported into the United States by you, on your behalf, or by any of your customers."

(Shoiket Decl., Exh. 1 at 2, Exh. 2 at 2). Fairchild's first set of interrogatories and its first set of requests for production both include a number of discovery requests directed towards information regarding the design, manufacture, testing, operation, structure and function of AOS's "accused product(s)." (Shoiket Decl., Exh. 1 at 4-6, Exh. 2 at 5-7). In particular, interrogatories 1-5 and 8-12, and requests for production 1-10 and 14-21, all reference AOS's "accused product(s)." (Shoiket Decl., Exh. 1 at 4-6, Exh. 2 at 5-7).

AOS served its responses and objections to these requests on September 28, 2007. (Shoiket Decl., Exhs. 3 and 4). AOS interposed the following objection to Fairchild's definition of "accused product(s)" in the "General Objections" section:

> 4. AOS objects to Fairchild's definition of "accused product(s)" as overly broad. As Fairchild has defined the term, it purports to encompass ***each and every trench MOSFET product*** that AOS has ever made, used, offered for sale, sold or imported. AOS will treat this term as referring to the following trench MOSFET products that were identified by Fairchild in a letter dated August 3, 2005, from Stephen Schott to Dr. Michael Chang: AO4812, AO4912, AOD412, AOD414, AOD404, AOD406, AO4407, and AO4422.

(Shoiket Decl., Exh. 3 at 3, Exh. 4 at 3) (emphasis added). AOS incorporated its general objection to Fairchild's definition of "accused product(s)" throughout its responses, refusing to provide any information in its interrogatory responses, or to produce any documents, relating to products other than the eight products specifically referenced in AOS's objection to the definition of "accused product(s)." (Shoiket Decl., Exh. 3 at 3-8, Exh. 4 at 3-10). Thus, AOS has limited the scope of its discovery obligations in this case to those eight products.

In a letter from AOS's counsel to Fairchild's counsel dated October 25, 2007, AOS again stated that it is limiting the scope of "accused products" as that term is used in Fairchild's discovery requests to the eight products identified in the August 3, 2005 letter. (Shoiket Decl., Exh. 6 at 2). In the

October 25 letter, AOS's counsel asserted that its objection to Fairchild's definition of "accused product(s)" is related to its objection to the sufficiency of Fairchild's PICs. (Id.). Specifically, AOS's counsel stated that "[t]he PICs served by Fairchild fail to provide any guidance as to what products are at issue in this case. Fairchild's PICs, as with its definition of accused products, purport to cover an indiscriminate array of AOS's MOSFET products." (Id.). AOS also stated that "Fairchild's PICs are legally insufficient to identify more than the products identified by Fairchild in its August 3, 2005 letter." (Id.).

The October 25 letter explicitly tied AOS's refusal to provide discovery on anything but eight of its power MOSFET products (out of approximately 342 accused power MOSFET products) to purported deficiencies in Fairchild's PICs. (Shoiket Decl., Exh. 6 at 2). However, as explained in Fairchild's opposition to AOS's motion to strike Fairchild PICs, filed concurrently herewith, Fairchild's PICs clearly and unambiguously identified the accused products and provided results of reverse engineering analyses that shows how the asserted claims of Fairchild's patents read on the accused products. (Fairchild's PICs are attached to the Declaration Of Brett M. Schuman In Support Of AOS's Motion To Strike Fairchild's Patent Local Rule 3.1, ("Schuman Decl."), Exh. A). Moreover, discovery is not limited by the patentholder's PICs. *See Epicrealm, Licensing, LLC v. Autoflex Leasing, Inc.*, 2007 WL 2580969 (E.D.Texas, Aug. 27, 2007) (construing Eastern District of Texas patent local rules which are substantively the same as the Northern District of California's patent local rules).

In its PICs, which were served on August 31, 2007, Fairchild explicitly accused 342 of AOS's power MOSFET products listed in Exhibit 1 to the PICs of infringing various claims of U.S. Patent Nos. 6,429,481 ("the '481 Patent"), 6,521,497 ("the '497 Patent"), 6,710,406 ("the '406 Patent"), and 6,828,195 ("the '195 Patent"). (Schuman Decl., Exh. A). Exhibit 1 to the PICs, which is entitled "MOSFET Selector Guide – All Products" ("the MOSFET Selector Guide"), lists all 342 of AOS's trench power MOSFETs that were available at the time of the service of the PICs, and which are accused of infringing the Fairchild patents. (Id.) The MOSFET Selector Guide provides detailed information about each of those 342 products, such as its configuration (e.g., single, dual, complementary), its type (e.g., p-channel, n-channel), its drain-source voltage (V_{DS}), and numerous

other parameters. (Id.)

Fairchild's PICs also contain detailed claim charts, supported by reverse-engineering analyses, for the 14 AOS trench power MOSFET products analyzed by Fairchild as part of its pre-filing investigation. (Schuman Decl., Exh. A). These 14 parts are included in the list of 342 AOS power MOSFETs provided in the MOSFET Selector Guide. (Id.) With regard to these 14 parts, Fairchild stated:

> These claim charts are based on information available to Fairchild at this time and are based, in part, upon reverse engineering of a reasonable sampling of AOS products. Fairchild contends that each of the accused AOS products meets the limitations of the asserted claims because, based upon their published characteristics, they are likely to have the same design and structure as the products for which reverse engineering data is provided. In addition, each of the accused AOS products is likely to have been manufactured using a process that is the same or similar in all respects relevant to the asserted claims as the products for which reverse engineering data is provided.

(Id.)

The August 3, 2005, letter referenced in AOS's general objections to Fairchild's discovery requests was written by Stephen Schott, Director of Patents and Associate General Counsel at Fairchild, to Dr. Michael Chang, the CEO of AOS, as part of the parties' licensing negotiations in 2005. (Shoiket Decl., Exh. 8). The letter described prior communications between several senior employees at Fairchild and Dr. Chang regarding the possibility of AOS taking a license to four of the Fairchild patents that are at issue in this litigation. (Id.) In addition to identifying eight AOS products, the letter also stated that Fairchild believed that a wide range of additional AOS products are covered by these Fairchild patents. (Id. at 1). Fairchild's accusation of infringement cannot be limited to a few products identified by Fairchild in licensing negotiations that took place two years before this action was filed.

In a letter from AOS's counsel to Fairchild's counsel dated November 6, 2007, AOS abandoned its position that it would product discovery on only the eight AOS products listed in the August 3, 2005 letter. (Shoiket Decl., Exh. 7). In that letter, AOS repeated its position that the definition of

"accused product(s)" in Fairchild's discovery requests is overly broad.[2] (Id.) AOS also recognized, however, that Fairchild's PICs identify ten additional AOS products that were not previously identified in pre-litigation correspondence.[3] (Id.) AOS stated that it will produce discovery on these additional ten AOS products, in addition to the eight AOS products listed in the August 3, 2005 letter. (Id.) AOS still refuses, however, to produce discovery on the remaining 324 products explicitly identified in Fairchild's PICs. (Id.)

III. ARGUMENT

A. Fairchild's Definition Of "Accused Product(s)" Is Not Overly Broad

AOS objects to Fairchild's definition of "accused product(s)" as being overly broad, arguing that the definition "purports to encompass each and every trench MOSFET product that AOS has ever made, used, offered for sale, sold or imported." (Shoiket Decl., Exh. 3 at 3, Exh. 4 at 3). AOS also argues that Fairchild's definition of this phrase is "so vague and overly broad that it fails to put AOS on fair notice of the products that Fairchild suspects are infringing its patents." (Shoiket Decl., Exh. 6 at 2). AOS provides no explanation, however, as to why seeking discovery on AOS's entire trench power MOSFET product line is overly broad. If all of AOS's trench MOSFET products infringe Fairchild's patents, as Fairchild believes they do, then Fairchild is entitled to discovery on all those products.

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[2] AOS also stated in the November 6, 2005, letter that Fairchild's PICs for the '111 and '947 Patents, which were served on October 29, include a narrower identification of accused products than is provided in the PICs for the '481, '497, '406, and '195 Patents. The reason why the PICs for the '111 and '947 Patents includes a narrower identification of products is because Fairchild believes that only a subset, and not all, of AOS's trench MOSFET products infringe those patents. Fairchild believes that all of AOS's trench MOSFET products infringe the '481, '497, '406, and '195 Patents. Therefore, Fairchild cannot agree to limit the number AOS trench MOSFET products accused of infringing the '481, '497, '406, and '195 Patents, as it has done for the '111 and '947 Patents.

[3] The August 3, 2005, letter listed AO4812, AO4912, AOD412, AOD414, AOD404, AOD406, AO4407, and AO4422 as being covered by Fairchild's patents. Fairchild's PICs include reverse-engineering analysis for fourteen AOS products, specifically AO4410, AO4413A, AO4422, AO4468, AO4704, AO4812, AO4914, AO6402, AO6405, AOD414, AOL1412, AO4912, AOD438, and AOL1414. Thus, Fairchild's PICs provide reverse-engineering analysis for four of the AOS products that were identified in the August 3, 2005 letter. Ten of the AOS products for which reverse-engineering analysis is provided in the PICs were not listed in the August 3, 2005 letter.

The scope of discovery in all federal court litigation, including patent cases, is set forth in Federal Rule of Civil Procedure 26(b)(1), which provides that:

> Parties may obtain discovery regarding ***any matter, not privileged, that is relevant to the claim or defense of any party***, including the existence, description, nature, custody, condition, and location of any books, documents, or other tangible things and the identity and location of persons having knowledge of any discoverable matter. For good cause, the court may order discovery of any matter relevant to the subject matter involved in the action. Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence. All discovery is subject to the limitations imposed by Rule 26(b)(2)(i), (ii), and (iii).

(Emphasis added). Fairchild's discovery requests relating to AOS's "accused product(s)" are relevant to Fairchild's claims of patent infringement and reasonably calculated to lead to the discovery of admissible evidence. As clearly stated in the PICs and reflected in the corresponding definitions of "accused product(s)" in Fairchild's discovery requests, Fairchild has accused AOS's entire line of power MOSFETs of infringing Fairchild's '481, '497, '406, and '195 Patents. (Schuman Decl., Exh. A; Shoiket Decl., Exh. 1 at 2, Exh. 2 at 2). Fairchild's infringement assertions are based upon a detailed pre-filing investigation of the design and process of manufacture of a reasonable sample of fourteen of AOS's power MOSFETs, as reflected in the reverse-engineering results of AOS's products supporting Fairchild's PICs.[4] (AOS has never complained about the sufficiency of the PICs as they relate to the fourteen products, yet AOS even refuses to provide discovery on some of *those* products.) AOS has no basis for limiting its discovery obligations to some artificially narrow subset of the accused products of its own choosing.

Fairchild has on several occasions offered to enter into an agreement that would limit discovery and trial to a set of accused products that are representative of other products. *See, e.g.*, Joint Case Management Conference Statement (Docket No. 28) at p. 6. Such an agreement is typically entered into in semiconductor patent litigation as a means of reducing discovery costs and

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[4] A Declaration of Dr. Richard A. Blanchard accompanies Fairchild's opposition to AOS's motion to strike Fairchild's PICs. In his declaration, Dr. Blanchard, who is a noted semiconductor expert, explains why it is reasonable to assume that ***all*** of AOS's power MOSFETs have a similar design and are made by a similar process as those products for which reverse engineering was performed.

trial time. Such agreements make sense because many semiconductor products are of similar design and manufacture. AOS has refused to enter into such an agreement. Consequently, any argument by AOS that Fairchild's discovery requests are overbroad is disingenuous.

B. Fairchild's Preliminary Infringement Contentions Do Not Limit The Scope Of Discovery In This Litigation

After first arguing that the definition of "accused product(s)" is overly broad, AOS then argues that Fairchild's PICs do not provide any clarification as to what products are being accused of infringement. (Shoiket Decl., Exh. 6 at 2). AOS's argument is wrong for two reasons. First, in its PICs Fairchild clearly identified by part number every AOS product accused of infringement as of the date the PICs were served. (Schuman Decl., Exh. A). Second, the PICs themselves do not serve to limit the scope of discovery. The scope of discovery is set forth in Federal Rule of Civil Procedure 26(b). The Northern District of California's Patent Local Rules do not introduce any limits on the scope of discovery beyond what are set forth in the Federal Rules of Civil Procedure. In particular, the portions of the Patent Local Rules dealing with Preliminary Infringement Contentions do not state in any way that the PICs are intended to limit the scope of discovery.

While Fairchild could not find a decision from the Northern District of California that specifically addressed the effect of the PICs on the scope of discovery, other jurisdictions have issued such decisions. In particular, the Eastern District of Texas, which has adopted patent local rules that model those adopted by the Northern District of California, has held that the scope of discovery in a patent case is not limited by the PICs. In *Epicrealm, Licensing, LLC v. Autoflex Leasing, Inc.*, 2007 WL 2580969 (E.D. Texas, Aug. 27, 2007), the District Court for the Eastern District of Texas addressed the issue of "whether the scope of discovery should be strictly limited to the products and services specifically identified in the patent holder's PICs." *Id.* at *2. The court held that:

> … the Court finds no bright line rule that discovery can only be obtained if related to an accused product identified in a party's PICs. For example, the Dallas Division of the Northern District of Texas has adopted local rules for patent cases directing that "the scope of discovery is not limited to the preliminary infringement contentions or preliminary invalidity contentions but is governed by the Federal Rules of Civil Procedure." § 2-5, Miscellaneous Order No. 62 (Apr. 2, 2007). The Court infers that this Dallas Division local rule intends that the scope of discovery is determined on a case-by-case basis and as contemplated by the "relevant to the claim or defense of any party" language in Federal Rule of Civil Procedure 26(b)(1). Further, Judge

> Ward of the Eastern District of Texas has found that relevant discovery in a patent infringement suit "includes discovery relating to the technical operation of the accused products, as well as the identity of and technical operation of any products reasonably similar to any accused product." *See, e.g., Microunity Sys. Eng'g, Inc. v. Advanced Micro Devices, Inc.*, 2-06-cv-486, Dkt. No. 38 at ¶ 3 (E.D.Tex. May 23, 2007).
>
> The Court concludes that the scope of discovery may include products and services (in this case, websites and systems) "reasonably similar" to those accused in the PICs. *Id.* This finding best comports with the "notice pleading and broad discovery regime created by the Federal Rules" and the "right to develop new information in discovery." *O2 Micro Int'l, Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1366 (Fed. Cir. 2006).

Id. at *3. Thus, the Eastern District of Texas, whose local patent rules closely follow those of the Northern District of California, has expressly rejected the argument that discovery is limited to the specific products listed in a plaintiff's PICs. *Id.*

C. AOS Has No Justification For Limiting The Scope Of Discovery To The Eighteen AOS Products Listed In The November 6, 2007, Letter

There is simply no justification for limiting AOS's discovery obligations to the eighteen AOS products identified in the November 6, 2007, letter. The Northern District of California has at least implicitly stated that all the products disclosed in a plaintiff's PICs, and not some subset of those products, are within the scope of discovery. In *IXYS Corp. v. Advanced Power Technology, Inc.*, 2004 WL 1368860 (N.D.Cal. June 16, 2004), the plaintiff's PICs accused the following products:

> (a) any and all Power MOS 7® products or Power MOS V® (Generation 5) products with dual-layer metallization manufactured, used, sold, or offered for sale by APT on or after August 15, 1996, and
>
> (b) any and all products manufactured, used, sold, or offered for sale by APT on or after August 15, 1996 ***that are designed in substantially the same way, or function in substantially the same way***, as APT 5018BLL [a Power MOS 70 MOSFET].

Id. at *3 (quoting Plaintiff's Disclosure of Asserted Claims and Preliminary Infringement Contentions) (emphasis added). With regard to the defendant's discovery obligations under Patent Local Rule 3-4(a), the court stated that "[b]y consequence [of the plaintiff having accused these products in its PICs], it is documents describing *those* devices that APT was obligated to produce …." *Id.* Thus, the scope of discovery in the IXYS case covered two ***families of products*** having a particular feature (i.e., all "Power MOS 7® products" and all of the "Power MOS V® (Generation 5) products" having dual-

layer metallization), as well as all products that were ***designed in substantially the same way*** or that ***functioned in substantially the same way*** as a particular product (the "APT 5018BLL power MOSFET"). In other words, the scope of discovery included every accused product that was listed in the PICs, not even excluding other family members that were not listed specifically by name, and not excluding products that had similar characteristics to the specifically enumerated products.

In this case, Fairchild has explicitly accused 342 of AOS's power MOSFET products of infringing Fairchild's patents. (Schuman Decl., Exh. A). Fairchild's PICs could not be any clearer in identifying the products that are accused of infringement.

IV. CONCLUSION

For these reasons, Fairchild respectfully requests that the court compel AOS to supplement its discovery responses to include information related to all of its systems of products, including but not limited to modules, containing trench design power MOSFETs or IGBTs made, used, offered for sale, sold, or imported into the United States on its behalf, or by any of its customers, as originally requested by Fairchild, within fourteen days of the issuance of the Court's Order.

DATED: November 6, 2007 TOWNSEND AND TOWNSEND AND CREW LLP

By:/s/*Igor Shoiket*
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Attorneys for Defendant and Counterclaimant.
FAIRCHILD SEMICONDUCTOR CORPORATION

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